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09/821,519	03/29/2001	Richard H. Krafchin	THS/001	6087

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EXAMINER

HARRELL, ROBERT B

ART UNIT PAPER NUMBER

2142

DATE MAILED: 06/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/821,519

Applicant(s)

KRAFCHIN, RICHARD H.

Examiner

Robert B. Harrell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2001 et al.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-26 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 29 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

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Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 20020903.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☒ Other: see attached Office Action.

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1. Claims 1-26 are presented for examination.
2. The Information Disclosure filed February 26, 2003 is absent a copy of "Hansen, 'Enhancing documents with embedded programs: How Ness extends insets in the Andrew ToolKit'. 1990, pages 23-32" and has thus not been considered by Examiner.
3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The claims are more directed to: System For Generating and E-Mailing Animated Presentations Using Embedded Email Client Executable Code.
4. The Specification is objected because figures should be individually mentioned in the Brief Description of the Drawings and not grouped together (i.e., use "FIG. 4,5,6,7,8,9,10, and 11 are" and not --FIG. 4-11 are--). Also, use of active hyperlink and/or other forms of browser executable code is improper (see MPEP 608.01) and must be removed (see on page 3 "www.ietf.org" which must be deleted.).
5. While negative limitations (e.g., see claims 12, 13, 25 and 26) are permitted per MPEP 2173.05(i) and have express basis in the disclosure (e.g., see page 8 (lines 25-30 (for example))), it is advised that they should be strongly avoided and to use phrases such as "the method is free from" in place of "no" and "is free from" in place of "does not have". These alternative phrases should not be construed as improved mode of definitions, since they define the same thing specifically an absence of these limitations, but rather enhances above the adequately provided clarity in addition provides a means about the limitations of the English language to define the boundaries of an invention free of plug-ins or free of email attachments normal in prior art technology and brings the claims more so in compliance with In re Wakefield, 422 F.2d 897, 899, 904, 164 USPQ 636, 638, 641 (CCPA 1970).
6. The applicant should also use this period for response to thoroughly and very closely proof read and review the whole of the application for correct correlation between reference numerals in the textual portion of the Specification and Drawings along with any minor spelling errors, general typographical errors, accuracy, and clarity of meaning in the Specification, Drawings, and specifically claims (i.e., "said" should be used after -sending- on line 7 of claim 1 for more clarity of meaning within the claim and for use by other claims such as claim 2 so it is known there is only one email client executable code and not two different email client executable codes).
7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this action:

A person shall be entitled to a patent unless -

- (e) the invention was described in-
- (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published

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under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a); or

8. Claims 1-26 are rejected under 35 U.S.C. 102 (e) as being anticipated by Gever et al. (US 6,329,994 B1 (filed March 14, 1997)).

9. Prior to addressing the grounds of the rejection, it is not mandatory for an examiner's Office Action to refer an applicant's attention to relevant and helpful elements, figures, and/or text upon which the examiner relies to support his or her position. However, should this application later issue as a Letter of Patent subject to public review by third parties not so versed with the technology, citation to figures and text within the reference correlating to claimed limitations are none the less optionally included below only to serve as an aid for such parties. Thus the following citations are neither all-inclusive nor all-exclusive in nature. Hence, the whole of the reference is cited.

10. Per claim 1, Gever taught a method (e.g., see Abstract (second word)) for generating a presentation comprising:

a) creating (e.g., see col. 5 (line 36 "create") and col. 8 (line 53 "created")) a visual (eg., see col. 5 (line 28 "image")) representation (e.g., see col. 4 (lines 31-33 "representation")) of the presentation;

b) generating email-client-executable code (i.e., col. 8 (line 60 "JAVA applet [script] or HTML file") corresponding to the visual representation (e.g., see col. 4 (line 2 for "electronic mail" (Official Notice that "electronic mail" means "email"), and col. 8 (lines 53-62));

c) sending email-client-executable code to recipient computer as part of an email (e.g., see figure 17B ("SEND"), col. 8 (line 66 "sent"), col.11 (line 7 "transmitting"), col. 28 (line 11), and col. 29 (line 51 "send")) ; and

d) causing the presentation to be displayed (e.g., see col. 31 (line 17 "displayed")) in response to the recipient (e.g., see col. 31 (line 18 "recipient")) opening the email (e.g., see col. 31 (line 21 "opened")) (e.g., see figure 18B).

11. Per claims 2 and 3, see col. 5 (line 61) and/or col. 8 (line 60).

12. Per claim 4, JAVA is "A Programming Language". The applicant should be more specific as to the meaning of "APL". None the less, due to the animation and meta code usage in Gever, APL is well suited for his system and inherently anticipated as called for by col. 8 (lines 60-61 "or in another standard file format") and col. 31 (line 37 "of other types"). Since Gever is directed to a non-expert user (e.g., see col. 3 (line 17)) and since APL is a user-oriented notation, particularly well suited for communication from people to other people or to computers, where the notation consists of a set of symbols (letters, numbers, punctuation, algebra, and special shapes), with a very simple set of rules (meta syntax) for putting them together to describe the processing of data. The data can be either numeric or literal (which

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includes words and text handling) all inherent to defining animation and thus APL was an anticipated "other standard file format".

13. Per claims 5,6,7, and 8, such is a function of compiling JAVA where variables "template fields" are finally replaced with constants such as from an sender's email address book for multiple recipients via a presentation server per figure 15, col. 28 (lines 12-65), and per col. 29 (line 53) to col. 30 (line 26).

14. Per claims 9 and 10, see col. 29 (line 20 "response") and col. 29 (lines 15-52) for updating the presentation in response to the response.

15. Per claims 11, see col. 4 (lines 37 and 62 "embedded") and col. 5 (line 64 "embedded").

16. Per claim 12, see col. 20 (line 43 "plug-in") but then note col. 20 (line 47).

17. Per claim 13, Gever makes no reference to an email attachment; everything is sent as JAVA and/or HTML directly in the email body (see figure 17B (far right "SAVE" AS HTML" and "SEND")) and figure 16 with col. 29 (lines 53-59).

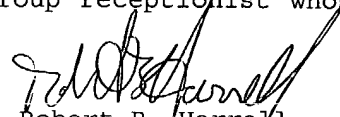
18. Per claims 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, and 26, these claims do not teach or defined above the correspondingly cited reasons given above, and are thus rejected for the same reasons as given above since the creator of an animation is an artist.

19. A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the data of this letter. Failure to respond within the period for response will cause the application to become abandoned (see MPEP 710.02, 710.02(b)).

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Harrell whose telephone number is (703) 305-9692. The examiner can normally be reached Monday thru Friday from 5:30 am to 2:00 pm and on weekends from 6:00 am to 12 noon Eastern Standard Time.

21. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack B. Harvey, can be reached on (703) 308-9705. The fax phone numbers for the Group are (703) 746-7238 for After-Final, (703) 746-7239 for Official Papers, and (703) 746-7240 for Non-Official and Draft papers.

22. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.


Robert B. Harrell
Primary Examiner
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